

## REMARKS

Claims 1-12 and 43-49 are pending in the application. Claims 1, 4, 43, and 47 are independent. In the present Paper, no claims have been amended, canceled, or added.

### Rejection of Claims 1-12 and 43-49 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner maintained the rejection of claims 1-12 and 43-49 under 35 U.S.C. §103(a) as being obvious over U.S. Patent Publication No. U.S. 2004/0117831 to Ellis et al. (hereinafter “*Ellis*”) in view of U.S. Patent No. 5,790,935 to Payton et al. (hereinafter “*Payton*”). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach each and every element of the claimed invention. (MPEP §2143.) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int’l C. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). If a combination or modification to a reference is used, an Examiner must show that there is some expectation of success that the combination or modification proffered would predictably result in the claimed invention. Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the U.S. Supreme Court in *KSR* include the *Graham* factors of determining the scope and content of the prior art, ascertaining the differences between the claimed invention and the prior art, and resolving the level of ordinary skill in the pertinent art.

Once the *Graham* factual inquiries are resolved, the Examiner must explain why the difference(s) between the cited references and the claimed invention would have been obvious to one of ordinary skill in the art. The rationale used must be a permissible rationale. The USPTO promulgated Examination Guidelines for Determining Obviousness in View of *KSR* in the Federal Register, Vol. 72, No. 195 (October 10, 2007). These *KSR* Guidelines enumerate permissible rationales and the findings of fact that must be made under the particular rationale.

Applicant respectfully submits that the cited references fail to teach each and every element of the claimed invention. Representative claim 1 recites in pertinent part “broadcasting content descriptors, which are *sets of attribute values* that describe pieces available content being considered for potential inclusion in a future broadcast schedule, *but not included in a previous broadcast schedule*, to a plurality of clients” and “*further descriptive content describing pieces of content that are more likely to be ranked, rated, and/or consumed*” (emphasis added). Claims 4, 43, and 47 recite similar subject matter. Support for these changes according to at least one embodiment can be found in Applicant’s Specification in Figure 3 and accompanying description at page 12, line 16 to page 15, line 3, for example. Tables shown in Figures 7-14 illustrate examples of content descriptors, such as actor name, movie title, movie genre, etc.

In the Office Action, the Examiner states that *Ellis* discloses broadcasting content descriptors, which describe available content being considered for potential inclusion in a future broadcast schedule, to a plurality of clients; receiving feedback from at least one of the plurality of clients regarding the content descriptors, the feedback being an indication from the at least one of the plurality of clients of the relative desirability of the available content described by the content descriptors; refining a list of available content in response to the feedback to create the future broadcast schedule, wherein refining the list of available content prioritizes an order in which at least a portion of the available content described by the content descriptors will be broadcast.” Specifically, the Examiner cites “The user may be given the opportunity to select a sorting criteria, such as by year of release, by title, or by time of airing on television. The user may select any individual movie to find out if it is available...” for teaching “refining a list of available content in response to the feedback to create the future broadcast schedule, wherein refining the list of available content prioritizes an order in which at least a portion of the available content described by the content descriptors will be broadcast” recited in claim 1. In the Office Action, the Examiner concedes that *Ellis* fails to disclose “broadcasting the available content listed in the refined list of available content, according to the future broadcast schedule as prioritized by the refining, to the plurality of clients” as recited in claim 1, but cites *Payton* for this proposition. Applicant respectfully disagrees.

Applicant respectfully submits that *Ellis* in view of *Payton* fails to disclose “broadcasting content descriptors, which are sets of attribute values that describe pieces available content being considered for potential inclusion in a future broadcast schedule, but not included in a previous broadcast schedule, to a plurality of clients” as recited in claims 1, 4, 43, and 47. Applicant respectfully submits that the program guide data transmitted by main facility 12 in *Ellis* includes program times, channels, titles, descriptions, pay-per-view information, etc. Thus, a ***schedule*** of program times, channels, titles, descriptions, pay-per-view information, etc., are included in a ***previous broadcast*** in *Ellis*’ system to allow a user to select what to view from that previous broadcast schedule. For example, to know that a movie is available for viewing, the broadcast schedule for the video on demand and pay-per-view content in *Ellis* must first be broadcast to a user for the user to select the particular movie. That is, the user in *Ellis* sees a previous broadcast schedule of the available movies prior to making a selection. This is in contrast with embodiments of the present invention in which only content descriptors are broadcast for content being considered for potential inclusion in a future broadcast schedule. The actual broadcast schedule is not broadcast to a plurality of clients until “refining a list of available content in response to the feedback to create the future broadcast schedule” has been accomplished.

Applicant respectfully submits that *Payton* also suffers from the deficiencies in *Ellis*. That is, *Payton* fails to disclose “broadcasting content descriptors, which are ***sets of attribute values*** that describe pieces available content being considered for potential inclusion in a future broadcast schedule, but not included in a previous broadcast schedule, to a plurality of clients” as recited in claims 1, 4, 43, and 47. Applicant respectfully submits that in order for the subscribers in *Payton* to know what is available for viewing a broadcast schedule has to have been previously provided to the subscriber.

Applicant respectfully submits that *Ellis* in view of *Payton* also fails to disclose broadcasting content descriptors, which are sets of attribute values that describe pieces available content being considered for potential inclusion in a future broadcast schedule” and “***further descriptive content*** describing pieces of content that are ***more likely to be*** ranked, rated, and/or ***consumed***” as recited in the claims. “Content descriptors,” in general, can be considered as a set of descriptors or attribute values that describe pieces of content or data files available to be

broadcast or potentially be broadcast from server 103. “Further descriptive content” is limited to a smaller portion of the available content that is the content that is determined to be more likely in demand as indicated in the list created in block 311 of Figure 3. Further descriptive content that is cached by the client describes pieces of content that are more likely to be ranked, rated and/or consumed by the client. In embodiments of the present invention in which the available content includes movies, the further descriptive content may include movie trailers, box art, awards, movie scenes or the like. Applicant respectfully submits that the combination of *Ellis* and *Payton* fail to disclose the two features recited in the claims. Applicant respectfully submits that because the combination of *Ellis* in view of *Payton* fails to disclose each and every element in claims 1, 4, 43, and 47 claims 1, 4, 43, and 47 are patentable over *Ellis* in view of *Payton*.

Claims 2-3 properly depend from claim 1 and are thus patentable for at least the same reasons that claim 1 is patentable. Claims 5-12 properly depend from claim 4 and are thus patentable for at least the same reasons that claim 4 is patentable. Claims 44-46 properly depend from claim 43 and are thus patentable for at least the same reasons that claim 43 is patentable. Claims 48-49 properly depend from claim 47 and are thus patentable for at least the same reasons that claim 47 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-12 and 43-49.

Assuming for the sake of argument that the combination of *Ellis* in view of *Payton* discloses each and every element of claims 1, 4, 43, and 47, the Examiner has not met the burden of proof for a *prima facie* case of obviousness. As discussed above, the *KSR* Guidelines enumerate permissible rationales and the findings of fact that must be made under the particular rationale. One such rationale is termed “Combining Prior Art Elements.” This appears to be the basis for the Examiner’s rejection of claims 1-12 and 43-49.

According to the Examination Guidelines for Determining Obviousness in View of *KSR*, to use the “Combining Prior Art Elements” rationale as a basis for rejecting claims, an Examiner must articulate four things: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference being the lack of

actual combination of the elements in a single reference; (2) a finding that one of ordinary skill could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately; (3) a finding that one of ordinary skill would have recognized that the results of the combination were predictable; and (4) any additional findings based on the *Graham* factual inquiries to explain the conclusion of obviousness. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion of obviousness.

Applicant respectfully submits that the Examiner has not made at least two of the findings. For instance, the Examiner has not made a finding that one of ordinary skill could have combined the elements as claimed by known methods, and that in combination, *each element merely would have performed the same function as it did separately*. Nor has the Examiner made a finding that one of ordinary skill *would have recognized that the results of the combination were predictable*. According to the Examination Guidelines for Determining Obviousness in View of *KSR*, the Examiner has thus failed to make out a *prima facie* case of obviousness of claims 1-12 and 43-49 with respect to *Ellis* in view of *Payton*. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-12 and 43-49.

### CONCLUSION

Applicant respectfully submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Date: 10/30/2007

Jan Little-Washington

Jan Little-Washington

Reg. No. 41,181

(206) 292-8600

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
(206) 292-8600

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Cindy L. Morton 10/30/07

Cindy L. Morton

Date